

REMARKS

Claims 23-31 and 34-42 are pending in the application. Claims 1-22 and 32-33 were previously canceled, without prejudice, as being directed to a non-elected invention subject to restriction. Claims 23-31 and 34-42 are subject to restriction in the current action. The applicant respectfully traverses the restriction requirement.

As applicant is required in response to the election requirement to elect to prosecute the invention of either Group I, claims 23-31 or Group II, claims 34-42. The applicant elects, with traverse, to prosecute the claims of Group II, directed to a linkage assembly. Claims 23-31 are therefore withdrawn.

The applicant's election is with traverse. The action defines the two-way restriction by the following groups:

Group I: claims 23-31, drawn to a subassembly i.e., receiver, classified in class 29, subclass 729;" and

Group II: claims 34-42, drawn to an assembly, i.e., a linkage assembly, classified in class 29, subclass 428

Initially, the applicant traverses the characterization of the sub-assembly set forth in claims 23-31 as a receiver. It is clearly stated as sub-assembly usable in the manufacture of a receiver, not necessarily a receiver itself. Claims 34-42 are drawn to a linkage assembly, i.e., a sub-assembly, usable in the manufacture of a receiver. That is, the linkage assemblies may be used to couple components within the receiver.

The restriction acknowledges that inventions are related as subcombinations. However, it is alleged the inventions are distinct because they do not overlap in scope, are not obvious variants and at least one subcombination is separably usable. Thus, the action alleges the invention of Group I has separate utility such as for a hearing aid versus mechanical coupling components of a receiver as indicated by the Invention of Group II. The action also alleges as a basis for restriction that searching the inventions of Groups I and II would impose a serious burden on the examiner.

By imposing restriction among the two groups of claims, the U.S. Patent and Trademark Office (“PTO”) makes admissions that may compel it to issue at least two separate patents. Specifically, if the two-way restriction requirement is maintained, then the PTO admits:

The Group I apparatus is patentable over a disclosure of the Group II apparatus, and vice versa.

See, e.g., M.P.E.P. § 802.01 (8th Ed., Rev. 3, Aug. 2005). These admissions are necessary to the PTO’s entry of the restriction requirement and may be relied upon by the applicant during examination of this application and future divisional applications, unless the restriction requirement is withdrawn. If the PTO is not making these admissions regarding patentability, then the restriction requirement should be withdrawn.

Further, according to the M.P.E.P., a requirement for restriction between multiple inventions is proper only when the PTO establishes (1) that the claimed inventions are independent or distinct, and (2) there would be a serious burden on the examiner if restriction were not required:

If the search and examination of all the claims in an application can be made without serious burden, **the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.**

M.P.E.P. § 803 (emphasis added).

The applicant acknowledges that “a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in M.P.E.P. § 808.02.” M.P.E.P. § 803(II). However, in the instant case, any *prima facie* showing of serious burden is rebutted because the search of one group will necessarily include a search of the other group. *Id.* (stating that a “*prima facie* showing [of serious burden] may be rebutted by appropriate showings or evidence by the applicant”).

The claims of Groups I and II are concerned with and recite related subject matter; specifically in that Group I recites a subassembly usable in a receiver while Group II

claims a linkage assembly, also usable in a receiver. The subject matter recited in all of the pending claims is sufficiently similar such that a complete search directed to the Group I subassembly or the Group II linkage assembly would necessarily include a search directed to the inventions of both Group I and Group II.

Because search and examination of the Groups I and II can be performed without serious burden on the PTO, requiring the applicant to prosecute those claims in separate patent applications would waste the time, effort, and resources of both the applicant and the PTO. Furthermore, the applicant will likely incur additional prosecution costs associated with filing multiple divisional applications and the PTO will be required to perform duplicative searches if the restriction requirement is maintained. Thus, withdrawal of the restriction requirement relative to Groups I and II will actually reduce the burden on the PTO and on the applicants.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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